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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,286	11/12/2003	Robert J. Mills	14649	9293

7590
SHELDON & MAK
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EXAMINER

AYRES, TIMOTHY MICHAEL

ART UNIT	PAPER NUMBER
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3637

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/712,286

Applicant(s)

MILLS ET AL.

Examiner

Timothy M. Ayres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-14 is/are allowed.
- 6) ☒ Claim(s) 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/21/06 has been entered.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Regarding claims 9-16, A first section with a bottom wall, a pair of opposed sidewalls, a front wall, and a rear wall is not described in the specification. A second section with a bottom wall, a front wall, and a rear wall is not described in the specification. The specification refers to a lower and upper compartment of the pencil case. Assuming that the first and second section are the upper and lower compartment the specification still does not define the bottom wall, the pair of opposed sidewalls, the front wall, and the rear wall for each compartment and only defines a bottom wall, a pair of opposed sidewalls, a front wall, and a rear wall for the entire pencil case that includes both upper and lower compartments. The

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combination of figures 1, 2, and 3 clearly show these elements and should be described in the specification in greater detail to discuss these elements shown in the figures.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the details of the first and second sections as shown in figures 1-3 must be labeled (following an updated description describing the elements as claimed) or the feature(s) should be canceled from the claim(s). No new matter should be entered.

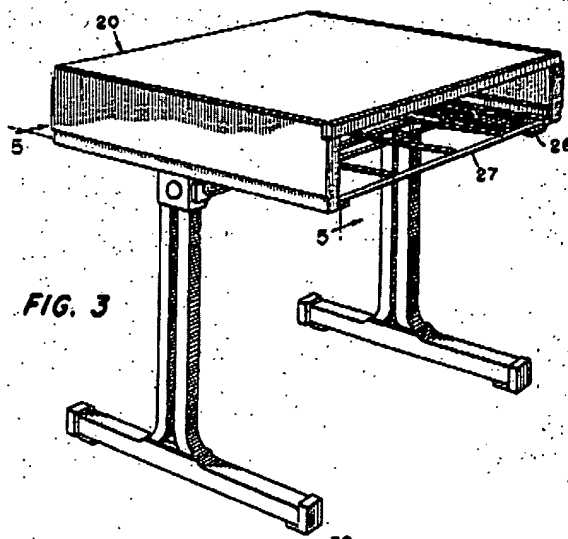
Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 3,758,182 to Barecki in view of US Patent 2,535,743 to Lundahl and US Patent 6,056,178 to Rapp-Duncan. . Barecki ('182) teaches in Fig. 3, a desk (20) with a top (21) and a support structure (24). The desk (20) is bottomless with support runners (26) that define the front opening. The runners (26) support a bottom rack (27), which is made of wire mesh and has many openings. In figures 6 and 7 Barecki teaches a pencil case (28) that could replace the bottom rack (27) on the desk and thus is teaching a desire to have a pencil case in that location.



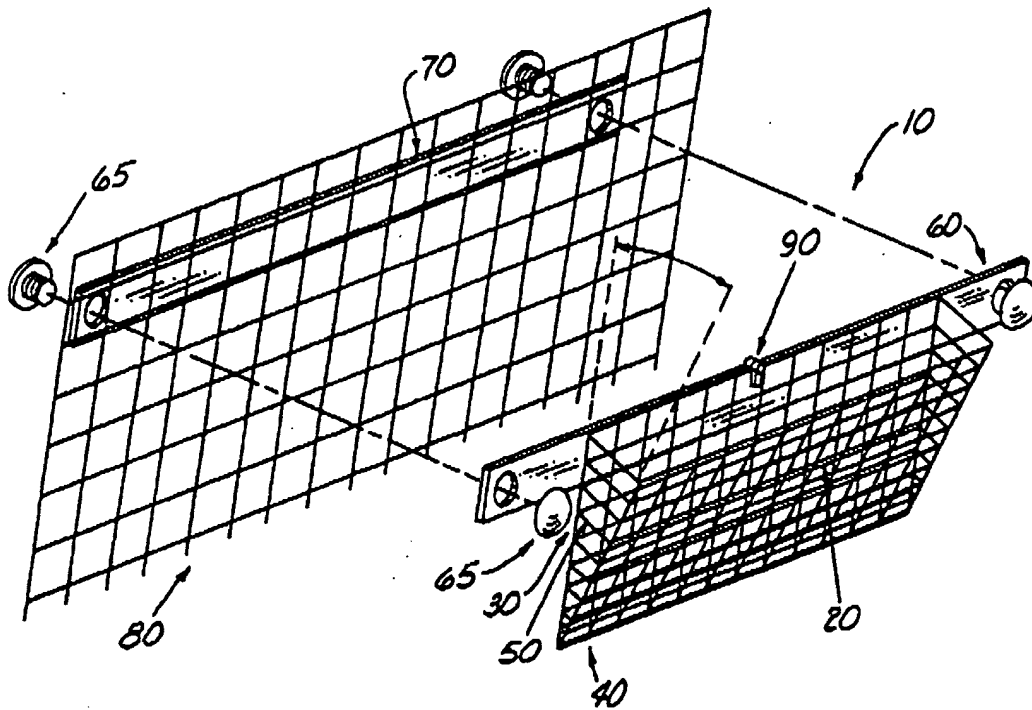
Barecki ('182) Fig. 3

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5. Barecki ('182) does not disclose expressly a pencil case attached with a pencil case attachment plate to the bookrack, a portion of the pencil case being disposed below the bottom wall of the book rack, and the pencil case with a bottom wall, a pair of opposed side walls, a front wall and a rear wall.

6. Lundahl teaches a pencil case (5) that has a portion (14) that is below the bottom of the typewriter (13) and the portion (14) is considered a bottom wall of the pencil case (5). The pencil case (5) has a first section (8) with a bottom wall (A'), opposing side walls (B', C'), a front wall (D'), and a rear wall (E'). The first section (8) is sized to retain a ruler or protractor within the walls. Rulers and protractors come in many sizes including some that are relatively small. Also note; a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). The pencil case is comprised of an upper compartment/ first section (8) and a lower compartment/second section (7). The lower compartment (7) is disposed next to or outside the typewriter (13). The second section (7) has a bottom wall and walls in the shape of circle and the circular wall is considered to be made of a front wall, a rear wall, and opposing side walls integral formed together. A third section (9) is higher than the first section and has a bottom wall, front wall, and a rear wall.

8. At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the desk and book rack of Barecki by adding the pencil case as taught by Lundahl in the manner as taught by Rapp-Duncan since the pencil case would allow items such as pencils to be kept near the desk (Lundahl '743, col. 1, lines 7-20) and the attachment would be simple (Rapp-Duncan '178, Col. 2, lines 31-33).



Rapp-Duncan '178 Figure 1

Allowable Subject Matter

9. Claims 9-14 are allowed. The following is a statement of reasons for the indication of allowable subject matter: Claims 9 and 12 recite a pencil case with two sections and with the bottom walls of the two sections at different elevations and a pencil case attachment plate attached to both bottom walls to sandwich a portion of the wire mesh book rack bottom. Such a configuration is not taught or suggested in the prior art.

Response to Arguments

10. Applicant's arguments filed 12/21/06 have been fully considered but they are not persuasive. Lundahl teaches an attachment portion (14) that is considered a bottom wall of the pencil case (5). Lundahl teaches a configuration with a first and second section as substantially claimed, additionally it would be obvious to use the third section with added opposing side walls to replace the first or second section. Lundahl does not teach a pencil case attachment plate (not claimed in 15 and 16) or the case attached to a wire mesh book rack. This deficiency is taught in the reference to Rapp-Duncan who teaches an attachment plate when attaching a bin to a wire mesh structure (a manner to attach a bin to a mesh structure). Barecki does not teach away from the invention by using a pencil case a replacement of the bookrack; instead Barecki shows the need of a desk with a bookrack and a pencil cases. The pencil case of Barecki is taught as alternative to the book rack and has separate use away from the desk thereby not teaching away from having an additional pencil case associated with book rack. The applicant has stated on page 8 of the remarks filed on 12/21/06 that the invention is to solve a long standing problem of how to provide a pencil tray to student desks having a wire mesh book rack. Claims 15 and 16 as currently recited do not claim this and currently only claim the pencil case as being attached to the wire mesh bookrack and not with any specific attaching structure as seen in figures 2 and 3.

11. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

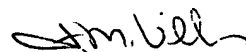
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Ayres whose telephone number is (571) 272-8299. The examiner can normally be reached on MON-THU 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TMA
01/03/07



JANET M. WILKENS
PRIMARY EXAMINER
Art Unit 3637